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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/132,746 08/12/98 YAMAMOTO

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NEW YORK NY 10112

EXAMINER

GUARRIELLO, J

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/132746

Applicant(s)

Yamamoto et al.

Examiner

John Gaerriello

Group Art Unit

1771

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10/6/2000 3/16/2001
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-78 is/are pending in the application.
- Of the above claim(s) 1-17, 31-41, 54-64 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 18-30, 42-53, 65-78 is/are rejected.
- ☒ Claim(s) 18, 19 and 42 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) #14, 16
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

15. The Examiner acknowledges papers # 14-16, IDS with certification of 10/6/2000, extension of time of 3/16/2001, and the amendment with attachment with the second IDS of, 3/16/2001.

16. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

17. Claims 19, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, it is not clear what the phrase “which can deliverably hold an ink jet ink therein” encompasses since there is no specificity as to amount or kind of component.

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In claim 30, line 2, it is not clear what the phrase “which can deliverably hold an ink jet ink therein” encompasses for the reason given in claim 19.

Election/Restriction

18. Applicant’s traversal is acknowledged but the restriction is made final as noted in paper # 13 of 9/11/2000. Furthermore, the restriction is still made final because the searches **do not overlap**, the **subject matter is divergent** and this would be burdensome. This is a petitionable issue. If applicant continues to traverse, then a petition must be filed.

Specification

19. The use of the trademarks as noted in paper #13 of 9/11/2000, namely, for example, “Acteylenol E-H” and “Surfonyl 465” pages 15 and 19-21, and other places have been noted in the specification of this application. They

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should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Applicant's remarks were considered, the Examiner directs Applicant to **MPEP 608.01(v)** in order to insure that the specification complies with accepted Patent Office Practice.

Claim Objections

20. Claims 18, 42, 65 are objected to under 37 CFR 1.75(c), as being of improper dependent form for **failing to further limit** the subject matter of a previous article claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the

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claim(s) in independent form. All claims should depend upon an **elected independent claim**.

Applicant's arguments regarding the second paragraph rejection of claims 18 and 42 were noted, the rejection of claims 18 and 42 was withdrawn. The **objection** of these claims, 18 and 42 is present.

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 18-21, 28, 30, 42, 45, 65, 71, 72, 76 are rejected under 35

U.S.C. 102(a) as being anticipated by EP 771 662.

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EP'662 describes an ink absorbing body which stores ink, (see abstract). EP'662 describes the surface of the ink absorbing body is treated with a surfactant, (page 8, lines 2-51), in the range of 0.002 to 0.2 wt% relative to the weight of the ink or in a range of 0.01 to 0.5 wt% relative to the weight of the fiber, (see abstract; page 7, lines 10-53). EP'662 describes polypropylene tank container, (page 10, lines 10-15). EP'662 describes the essential limitations of the claimed invention. Claims lack novelty.

Claim Rejections - 35 USC § 103

22. Claims 18-30, 42-53, 65-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ujita et al. 5,784,088 in view of Koitabashi et al. 5,509,140.

Rejection is maintained substantially as in paper # 13 of 9/11/2000.

Applicant's arguments have been considered regarding Ujita and the spun yarn and Koitabashi regarding the glycol treatment but they are not

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persuasive because taking the invention as a whole and without any criticality of the glycol treatment evidenced this claimed invention would still be obvious to one of ordinary skill.

23. Claims 22-27, 29, 43, 44, 46-53, 66-70, 73-75, 77, 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 771662 in view of GB 2059 975.

EP'662 as above in paragraph # 21. EP'662 differs from the claimed invention because the treating agent glycol is different.

GB'975 describes fibrous articles which are treated with ethylene oxide with polyhydric alcohol(glycol), (page 1, lines 5-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the ethylene oxide polyhydric alcohols (glycol) of GB'975 in EP'662 motivated with the expectation that there would be an improvement in the capillary action of the fibrous material since these glycols are chemical homologs and would facilitate in the ink retention.

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Double Patenting

24. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

25. Claims 18-30, 42-53, 65-78 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,234,618. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the hydrophobicity of the fibers of '618 with

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the surfactant described motivated with the expectation that treatment of the fibers by surfactants for hydrophobic properties is routine in this art and the optimization of the appropriate amounts of the surfactants and types of surfactants (non-ionic, ionic, or cationic) to accomplish this treatment of the fibers for hydrophobicity are routine to the person of ordinary skill in the fiber treatment art, see **In re Aller**, 105 USPQ 233.

26. Rejections not maintained under 35 USC 112 second paragraph are withdrawn, because the objection to claims 18, 19 and 42 is now an objection.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Guarriello whose telephone number is (703) 308-3209. The examiner can normally be reached on Monday to Friday from 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The

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fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

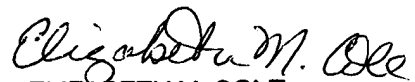


John J. Guarriello:gj

Patent Examiner

May 25, 2001

June 4, 2001



ELIZABETH M. COLE
PRIMARY EXAMINER